

## **REMARKS**

The Examiner previously indicated allowability of claims 35, 42, 43 and 51, but has withdrawn these allowances in view of newly discovered prior art, in particular Shaw and Azzar et al. The Examiner has indicated on the Office Action Summary that the action is final, but in bold in the specific action emphasized that the action is not final, and so the Applicant submits the present amendment.

The Examiner rejected claims 18 and 26-34 under 35 U.S.C. 102(b) as being anticipated by Nelson (US Patent 5,613,342). The Examiner also rejected claims 18-34, 36-41, 43-50 and 52 under 35 U.S.C. 103(a) as being unpatentable over Nelson in view of Raggio (US Patent 2,297,072) and further in view of Shaw (US Patent 6,553,732) and Azzar et al. (US Patent 5,157,886).

### **A. Applicant's Invention**

In contrast to the cited references, Applicant's invention involves a method of making and attaching molded elongated strips, particularly those formed by cast molding, to provide a great variety of surface features. Such surface features cannot be found in the typical elongated edges formed by extrusion or routers. Extrusion may create an elongated pattern which runs parallel to the length of an item, but not otherwise. Cast molding in particular offers the ability to create intricate patterns on the surface of the elongated molded strips. None of the cited references teaches an elongated strip that was cast molded, or that has an outer surface defining a non-extrudable shape such as ridges or recesses extending transverse to the length of the strip or an outer surface that includes one three-dimensional pattern superimposed over a portion of another in the manner that Applicant teaches. Nor do they teach patterns that repeat along the elongated direction of the strips.

### **1. Rejections and standard of examination under 35 U.S.C. 102(b)**

As previously noted, the Examiner rejected claims 18 and 26-34 under 35 U.S.C. 102(b) as being anticipated by Nelson (US Patent 5,613,342). In establishing a prima facie case of anticipation under 35 USC § 102, the Examiner must find every element of the applicant's claim in a single reference; other references may be used only to interpret the allegedly anticipated reference. Studiengesellschaft Kohle, m.b.H. v. Dart Industries, Inc., 726 F. 2d. 724, 220 USPQ 841 (Fed. Cir. 1984). This idea was similarly upheld in Scripps Clinic & Research Foundation v. Genentech, Inc., 927 F. 2d. 1565, 18 USPQ 2d. 1001, 18 USPQ 2d. 1896 (Fed. Cir. 1991), wherein the Court held "that invalidity for anticipation requires that all the elements and limitations of the claims be found in a single prior art reference."

Applicant respectfully disagrees with the Examiner concerning the rejection of claim 18. Nelson clearly does not teach a non-extrudable shape and for this reason alone, the rejection should be withdrawn. In addition, while claim 18 is currently amended for other reasons, even prior to the current amendment, claim 18 required a first three-dimensional pattern superimposed over a portion of a second three-dimensional pattern, the two patterns being distinct. No such patterns or superimposition of patterns is distinctly pointed out by the Examiner, nor does Nelson teach or suggest this limitation. Further, as amended, claim 18 indicates in part that the shape defined by the outer surface includes a first three-dimensional pattern and a second three-dimensional pattern which is distinct from the first three-dimensional pattern; wherein a portion of the first pattern extends transversely to and is superimposed over a portion of the second pattern. None of the limitations underlined are taught or suggested by Nelson. Applicant therefore submits that the rejection must be withdrawn regarding claim 18 and that claims 26-34 are allowable as depending from an allowable claim.

Inasmuch as Applicant's invention includes a molded strip with an outer surface defining a non-extrudable shape; that the shape defined by the outer surface includes a first three-dimensional pattern and a second three-dimensional pattern which is distinct from the first three-dimensional pattern; and that a portion

of the first pattern extends transversely to and is superimposed over a portion of the second pattern; Applicant submits that method of the present invention is patentably distinct from the cited reference.

## **2. Rejections and standard of examination under 35 U.S.C. 103(a)**

As noted above, the Examiner also rejected claims 18-34, 36-41, 43-50 and 52 under 35 U.S.C. 103(a) as being unpatentable over Nelson in view of Raggio (US Patent 2,297,072) and further in view of Shaw (US Patent 6,553,732) and Azzar et al. (US Patent 5,157,886).

The Examiner initially has the burden of factually supporting a *prima facie* conclusion of obviousness, which then shifts the burden of providing evidence for arguments to the Applicant who may submit additional evidence of non-obviousness in order to overcome the Examiner's rejection. MPEP 2142. To establish a *prima facie* case of obviousness, three basic criteria must be met. MPEP 2143. First, there must be some suggestion or motivation to combine the references, the three possible sources of which are the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. MPEP 2143.01, citing *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ 2d 1453, 1457-58 (Fed. Cir. 1998). Second, there must be a reasonable expectation of success in combining the references in order for it to be proper to combine them. MPEP 2143.02, citing *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Third, all the claim limitations must be taught or suggested by the prior art. MPEP 2143.03, citing *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

The rationale to modify or combine prior art references may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of the ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. MPEP 2144, citing, for example *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). The strongest rationale for combining references is a recognition, expressly or impliedly in the prior art or

drawn from a convincing line of reasoning based on established scientific principles or legal precedence that some advantage or expected beneficial result would have been produced by their combination. MPEP 2144, citing In re Sernaker, 702 F.2d 989, 994-95, 217 USPQ 1, 5-6 (Fed. Cir. 1983).

Motivation to combine references requires desirability, not merely what is a trade-off or what is feasible. Winner Int'l Royalty Corp. v. Wang, 202 F.3d 1340, 53 USPQ2d 1580 (Fed.Cir.), *cert. denied*, 530 U.S. 1238 (2000). A proposed combination that creates an inoperable device teaches away from the combination and cannot serve to create a prima facie case of obviousness. Tec Air, Inc. v. Denson Mfg. Mich. Inc., 192 F.3d 1353, 52 USPQ2d 1294 (Fed.Cir. 1999).

**B. References may not be properly combined / fail to teach or suggest the claimed limitations**

Applicant emphasizes that references must be properly combined in order to be used in establishing a case of obviousness. Applicant submits that the following combinations are improper: (1) Nelson and Raggio; (2) Raggio and Shaw; (3) Nelson and Shaw; and (4) Azzar et al. and Raggio. The improper combination of these references is discussed below. While Applicant strongly believes that said combinations are improper, Applicant further submits that even if these combinations are deemed proper, they do not teach Applicant's invention as claimed.

**1. Nelson and Raggio**

Nelson teaches a method of gluing a side molding to a counter top and the like, while Raggio teaches securing a side banding surrounding a desk top thereon by a strap under tension. Nelson secures a molding strip to a countertop edge with glue and in particular solves the problem of the overflow of excess glue in this context. Raggio holds band 8 to the desk top edge by wrapping band 8 with metal

strap 12 under tension. Nelson and Raggion each teach a unique method of securing such side molding or banding. As noted above, motivation to combine references requires desirability, not merely what is a trade-off or what is feasible. Winner Int'l, *supra*. With regard to the present references, there is no particular desirability to use one method over the other since each solves an analogous problem and at best would provide redundancy for no purpose. Quite simply, there is no advantage gained in combining the two references and therefore no motivation for such combination. Indeed, as discussed below, further argument against combining the two is substantial.

The metal strap 12 of Raggio is necessarily under tension in order to provide the means of holding band 8 onto the edge of the desk or table top. Such tension would be destructive to the finished and possibly decorative surface of the Nelson molding 14. Wrapping a metal strap under tension around the Nelson molding would damage the surface of the molding and disrupt the smooth alignment between molding 14 and top skin 18 by inward movement of molding 14 or by outward movement of molding 14 along the edges thereof in reaction to the adjacent inward compression in the central portion of molding 14. In addition, the Raggio method would not be feasible with the typical laminate used for countertops which is relatively tough, but also relatively brittle and would break in an effort to bend around corners sharp or curved.

In addition, the metal strap 12 of Raggio would not function with the typical square corners of Nelson and the like, as strap 12 would damage molding 14 at the corners and would present a problem in order to get metal strap 12 to lie flat against the molding adjacent the corners, i.e., it would be difficult at best to prevent metal strap 12 from projecting outwardly in an objectionable manner. Moreover, strap 12 of Raggio would cover any decorative aspect on the outer surface of the molding 14 of Nelson.

Moreover, the method of Raggio would not work for a counter top or the like where the outer circumference thereof did not form a substantially closed loop. That is, a counter top extending from a wall or other structure would not permit a

banding or strap to surround the edge thereof, thus precluding use of the Raggio method altogether.

For each of the above reasons, Applicant submits that Nelson and Raggio either teach away from combination or fail to teach or suggest any advantage for the combination. Thus, there is no motivation to combine the references nor a reasonable expectation of success in doing so. Applicant therefore submits that the rejections should be withdrawn.

## **2. Raggio and Shaw**

Shaw teaches an ornamental corner piece 100 for attaching to and covering a corner 102 and is used in particular with corner posts of homes or businesses. In short, corner piece 100 is configured to attach to each of walls 104a and 104b which are at right angles to one another and form corner 102. Corner piece 100 is a thin-walled structure having a decorative central portion 106 with walls 110a and 114a extending from central portion 106 and walls 110b and 114b extending also extending from central portion 106 in a direction substantially perpendicular to walls 110a and 114a. More particularly, walls 114a and 114b are nailing flanges through which nails are driven to connect corner piece 100 to respective walls 104a and 104b of a corner post or other corner. When corner piece 100 is installed on a corner post 102, sidewalls 112a and 112b are substantially parallel to and spaced from the sides of the corner post to define an interior space 116. Central portion 106 is also spaced from the corner of the corner post when corner piece is installed. Further, corner piece 100 defines a channel 112a between walls 110a and 114a distal central portion 106 and an analogous channel 112b between walls 110b and 114b distal central portion 106. Channels 112a and 112b are configured to receive the edges of siding panels attached to the walls 104a and 104b. A beaded cap 200 may be superimposed over central portion 106, preferably by snap-fit engagement in order to provide a removable decorative pattern as an alternate to central portion 106.

Applicant submits that combining Raggio with Shaw is improper. Applicant first submits that attempting to use corner piece 100 as a edge molding for a table top, desk top, counter top or like furniture would lead to absurd results because corner piece 100 is configured to attach to corner post 102 via the two walls 104 at right angles to one another whereas Raggio is configured to attach to a single edge of a table top or the like. One possibility would be that one of sidewalls 110 of Shaw would be disposed adjacent the furniture edge with the other sidewall 110 either atop or below the furniture. Whether one sidewall was atop or below, either result would be undesirable at best and most likely untenable altogether. Alternately, central portion 106 of Shaw could be disposed against the furniture's edge with walls 110 and 114 extending at an angle to the furniture top and with the edges of nail strips 114 projecting above and below the furniture top structure. This configuration is equally undesirable and/or untenable. Even if the corner piece 100 could be feasible sized down to fit the edge of the furniture at issue, nail strips 114 would contact the furniture edge with central portion 106 spaced outwardly from the furniture edge. Each of the above configurations at best would create a relatively flimsy "molding strip" on the furniture edge, which is not commensurate with the purpose of protecting the furniture edge with a solid, firm molding strip. The basic structure alone teaches away from combining the two references.

In order to have any semblance of creating a molding strip for protecting the edge of furniture, space 116 of Shaw corner piece 100 and the space which receives corner 102 would have to be filled in with a solid whereby the solid would define a rear surface extending more or less along a plane defined between the respective tips (unnumbered) of nail flanges 114 in order to provide a proper surface for attaching to the furniture edge. Making corner piece 100 into a solid structure similar to that of Raggio instead of the thin-walled structure which Shaw teaches (and which is clearly a part of the prior art of such corner pieces based on Figs. 1-2) would defeat the highly desirable characteristics of a light-weight, minimal-material (and thus relatively low cost) structure. More importantly, however, making such a solid structure would render corner piece 100 inoperable for its intended purpose

by eliminating the space in which corner 102 is received. Thus, the proposed combination creates an inoperable device, thus teaching away from the combination.

Applicant submits that the structure of corner piece 100 is unsuitable as a decorative strip attached to a desk or table top for other reasons as well. Raggio teaches elongated banding 8 wrapped around a desk top or the like and held on by a strap 12 forming a loop under tension around banding 8 and the edge of the desk. The strap 12 under tension is necessarily configured as an enclosed loop extending in the elongated direction of the banding 8 in order to surround banding 8 and the edge of the desk or the like and in order to provide the tension that is a critical part of the Raggio invention. Applying such a strap to the corner piece of Shaw is simply impractical, if not impossible. This alone teaches away from the combination of the two references. Even if it were otherwise feasible to combine Raggio with Shaw, doing so would lead to the compression of Shaw's corner piece 100 by the strap 12 of Raggio, thereby crushing the thin-walled corner piece 100 due to thin walls and the space between corner piece 100 and corner 102. This concept also teaches away from the combination of these two references.

Applicant further notes that the bending of band 8 to extend around the circumference of a desk or table is an essential part of the Raggio invention. By contrast, corner piece 100 cannot be situated in any orientation which would allow it to bend around the corners of a desk top like band 8 of Raggio without substantial deformation of corner piece 100, which would render it useless for its intended purpose. More particularly, due to the thin walls and the various convolutions of corner piece 100, such bending and consequent deformation would be unavoidable. Such bending would also prevent a member such as cap 200 from being retained on corner piece 100, thus defeating another key aspect of the Shaw invention.

In addition, the strap 12 of Raggio if combined with the corner piece 100 of Shaw would (1) cover up the ornamental aspect of portion 106 of corner piece 100 and interfere with the ability of cap 200 to connect to corner piece 100 if strap 12 were used between portion 106 and cap 200, and (2) cover cap 200 if used on the



outer surface of cap 200, thus covering the ornamental aspect of cap 200. This scenario also teaches away from the combination of Raggio and Shaw. For these various reasons, Applicant submits that there is no motivation to combine the two references nor a reasonable expectation of success in doing so. Applicant therefore submits that the rejections should be withdrawn.

### **3. Nelson and Shaw**

As noted earlier, Applicant also submits that combining Nelson with Shaw is improper. Applicant notes that the first argument used above against the combination of Raggio and Shaw is incorporated here as well, that is, that attempting to use corner piece 100 as a edge molding for a table top, desk top, counter top or like furniture would lead to the absurd results specified. Thus, Nelson and Shaw teach away from the combination thereof.

In addition, Applicant incorporates here the argument above, regarding the combination of Raggio and Shaw, that the combination of Nelson and Shaw would likewise render corner piece 100 of Shaw inoperable for its intended purpose by making it a solid structure and thereby eliminating the space in which corner 102 is received. Again, the references teach away from their proposed combination. Thus, there is no motivation to combine the references nor a reasonable expectation of success in doing so. Applicant therefore submits that the rejections should be withdrawn.

### **4. Azzar et al. and Raggio**

Applicant further submits that Azzar et al. cannot be properly combined with Raggio. As noted above, a key element of Raggio is the use of a metal strap 12 under tension and in the form of a closed loop to secure banding 8 to the edge of a table or the like. This concept is not applicable to use with a baseboard molding strip such as that of Azzar et al. Baseboards extend along the bottom of a wall and

do not lend themselves to being surrounded by the closed loop metal strap 12 of Raggio. Even if baseboards did present such a possibility, once again the metal strap 12 would tend to deform corners and cover up the three-dimensional patterns (ribs 12 and layer 34) taught by Azzar et al. In addition, Azzar et al. teach a method of attaching a baseboard strip to a wall using an adhesive such as a linoleum paste while Raggio teaches a method of attaching banding 8 to a table edge without the use of adhesives. Even if one of these methods was realistically applicable to the molding strip of the other invention, such combination would be at best a trade-off as opposed to something desirable, and thus teach away from said proposed combination. Applicant thus submits that there is no motivation to combine the two references and that the rejections should be withdrawn.

Applicant submits that even if the combination of the references discussed above are deemed proper, the addition of the teachings of Azzar et al. nonetheless fails to teach or suggest the various aspects of Applicant's invention not taught or suggested by the other references. Azzar et al. teach an extruded molding strip 10 which includes a rear layer 36 with horizontal parallel ribs 12 extending outwardly therefrom and an outer layer 34 on the tips of ribs 12. Ribs 12 and 34 are elongated in the same direction. Outer layer 34, while having differing coloring from the other material, is not a visibly distinct three-dimensional pattern from pattern of ribs 12, which form a second three-dimensional pattern. All of first three-dimensional pattern 34 is superimposed over second pattern 12 so that no portion of first pattern 34 is not superimposed over second pattern 12. First pattern 34 simply blends into second pattern 12 without enhancing the three-dimensional effect of superimposing one pattern over the other, in contrast to Applicant's invention. Even if first pattern 34 were to cover all of ribs or second pattern 12, no portion of the second pattern would be visible, thus making the superimposition of one pattern over the other meaningless in serving to enhance the three-dimensional aspect of the decorative function of Applicant's invention or the other cited references. In addition, layer 34 is formed of one material or composition and rear layer 36 and ribs 12 are formed of a different material or composition, thus teaching a dual layer

strip formed of two different materials or compositions in order to create the first three-dimensional pattern 34 and second three-dimensional pattern 12.

Applicant thus submits that the references teach away from combination as discussed above and that even if the references are combined, they do not teach or suggest Applicant's invention.

## **C. Hindsight Reconstruction**

### **1. Case law**

In addition, Applicant respectfully submits that the Examiner is engaging in impermissible hindsight reconstruction gleaned from the invention itself. Understanding that hindsight reconstruction is an easy trap to fall into, nonetheless the Examiner is required to place him or herself in the minds of those of ordinary skill in the relevant art at the time the invention was made to determine whether the invention, now plainly at hand, would have been obvious at the earlier time when it was invented. Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1138, 227 U.S.P.Q. 543 (Fed.Cir. 1985); W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553. "The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time." Interconnect Planning at 1138. The Examiner "cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." In re Fitch, 972 F.2d 1260, 23 USPQ 1780, 1784 (Fed.Cir. 1992), quoting In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed.Cir. 1988). Stated another way, the Examiner "cannot pick and choose among individual parts of assorted prior art references 'as a mosaic to recreate a facsimile of the claimed invention.'" Akzo N.V. v. U.S. Int'l Trade Comm'n, 808 F.2d 1471, 1 USPQ2d 1241, 1246 (Fed.Cir. 1986), *cert. denied*, 482 U.S. 909 (1987).

### **2. Application of case law to the present case**

Applying this standard to the present case, the Examiner should eliminate from his or her mind the teachings of Applicant's present invention, such as the highly variable and desirable non-extrudable shapes which include three-dimensional shapes such as transverse ridges and recesses, and three-dimensional patterns which may be superimposed over other three-dimensional patterns. Then, the Examiner should simply look at the references with which the rejections have been made and see if one of ordinary skill in the art would discover from those references which may be properly combined whether Applicant's invention is taught or suggested by the references. Applicant has provided ample argument above that the various references teach away from combination with one another, which also strongly supports the present argument. However, even if the various references may be properly combined, there is nothing about these references that suggests the ultimate result which Applicant has invented.

More specifically, when Nelson is reviewed, the overriding aspect of the invention is an improved method of attaching a thin sheet of laminate to the edge of the support decking of such furniture as counter tops and desk tops. While the Examiner states that "one can safely assume" that the exterior surface of the Nelson laminate includes a pattern, the Examiner does not specify what the pattern is. Based on the Examiner's referral to Fig. 3, Applicant takes the Examiner's comments to refer to the beveled edges of molding 104, as nothing else is evident from the Nelson patent. However, this beveled shape does no more than teach or suggest a variation which would be accomplished by a planer, a router or the like. The beveled shape is still no more than a simple non-extrudable shape.

A review of Raggio reveals banding 8 for attaching to the edge of a desk top or like furniture whereby a metal strap 12 is wrapped completely around banding 8 and put under tension in order to make the attachment to such furniture edges. As noted above, there are several substantial reasons against combining Nelson and Raggio, but even if they may be properly combined, the combination does not teach or suggest Applicant's invention. The main focus of Raggio is the method of

attaching banding 8 with metal strap 12, which is apparently a relatively simple process and one which covers screws, nails and the like previously used on the edge of the furniture. While a decorative concept is also an aspect of the invention, the possibilities are severely limited by the use of metal strap 12, which prevents the portion of banding 8 underlying strap 12 to be part of the decoration. The remainder of the decorative effect provided by banding 8 itself is also rather limited. More particularly, the outer surface of Raggio includes a pair of elongated, rounded ridges which are spaced from one another by a flat surface in which metal strap 12 is received and which extend parallel to the length of banding 8. Thus, Raggio teaches, once again, a simple, extrudable shape, that is, the cross section is the same along the entire length of banding 8.

Thus far, neither of these two references teaches or suggests the variety of patterns of Applicant's invention. No ridges or recesses which run transversely to the length of the molding is taught or suggested by either reference, and Raggio clearly teaches away from such ridges which extend across the central portion of banding 8 or which extend from one edge of banding 8 to the other edge, because metal strap 12 would prevent the same, because metal strap 12 needs to be seated in a slot or at least on a substantially flat surface. If such transverse ridges were included, metal strap 12 would either deform them due to tension or simply cover them up, making them a non-visible and therefore useless aspect of any pattern defined by the outer surface of banding 8.

Applicant now turns to Azzar et al., who teach an extruded elastomeric baseboard molding strip 10 including front layer 34 and a rear layer 36 with ribs 12 projecting therefrom. For the simple reason that molding strip 10 is extruded, Azzar et al. do not and cannot teach or suggest a nonextrudable shape such as transversely extending ridges or recesses. Nothing in the Azzar et al. patent teaches or suggest a molding strip which is formed by any other method than extrusion. Azzar et al. do teach an additional aspect, namely that the elongated front layer 34 covers the tips of elongated ribs 12, wherein layer 34 and ribs are both elongated in the elongated direction of the molding strip 10, as required by the

extrusion technique. While one material (layer 34) is superimposed over a different material (ribs 12), there is no three-dimensional surface distinction between front layer 34 and 12, as the two blend into one another. The only visible distinction between each layer 34 and rib 12 as seen when installed would be a color contrast, as Azzar et al. teach that front layer 34 is highly colorable to achieve such a contrast. However, even if there were a three-dimensional distinction between layer 34 and rib 12, Azzar et al. still do not and cannot teach or suggest a first three-dimensional pattern superimposed over a second three-dimensional pattern whereby a portion of the first pattern extends transversely to a portion of the second pattern.

Applicant has argued above that Shaw teaches away from combination with either Nelson or Raggio, and that argument is incorporated here to emphasize impermissible hindsight reconstruction. However, even if the references are combined, the only thing that might be gained from Shaw is the addition of a member similar to cap 200 which may be connected to a molding strip in order to provide alternate decorative options which may be changed as desired. This concept does not teach or suggest the concept of Applicant's invention, which is a molded strip of substantial thickness in contrast to the thin walls of Shaw corner piece 100. These thin walls of corner piece 100 spaced from walls 104 of corner 102 simply do not suit the solid structure of the molding strips taught by Nelson, Raggio and the Applicant. In addition, beaded cap 200 of Shaw is separate from and removable from corner piece 100 whereas Applicant's invention forms superimposed patterns with a single molded strip such that the patterns are a permanent aspect of the molded strip.

In short, absent the teaching of Applicant's invention, there is nothing in the cited references that teaches or suggests Applicant's invention as claimed.

The Examiner has stated, "The direction of the ridges and recesses has been considered a matter of design choice; one of ordinary skill in the art would have appreciated the direction that is commensurate with the intended purpose and function of the countertop/strip." The Examiner has also indicated that a non-

extrudable shape and the method of batch cast molding has been considered a matter of design choice. However, Applicant submits that the Examiner's conclusions to this effect are strictly related to hindsight reconstruction. That is, it is the very teaching of Applicant's invention that allows the Examiner to "pick and choose among individual parts of assorted prior art references 'as a mosaic to recreate a facsimile of the claimed invention'", which is not allowed by case law such as Akzo, supra. Without Applicant's invention in hand, the cited references simply fail to teach or suggest these characteristics. Even more, as has been presented above, the cited references actually teach away from combination in a host of ways and therefore should not be considered at all.

#### **D. Summary of arguments against obviousness rejections under 35 U.S.C. 103(a)**

Applicant submits that for all the many reasons discussed above, claims 18-34, 36-41, 43-50 and 52 are allowable. To begin with, the various references teach away from combination with one another and therefore may not be properly combined in order to establish a case of obviousness with regard to Applicant's claimed invention. Even if various of the references may be combined, they still do not teach or suggest Applicant's invention. Moreover, hindsight reconstruction may not be applied so that the teaching of Applicant's invention makes it appear that the cited references may be combined or somehow pieced together to presumably teach or suggest Applicant's invention when those cited references really should not be combined and/or really do not teach or suggest the invention.

#### **E. Arguments regarding particular claims**

Despite all the above arguments, Applicant has nonetheless amended claim 18 to indicate in part that the molded strip is formed as an integral one-piece member and that the shape defined by the outer surface includes a first three-

dimensional pattern and a second three-dimensional pattern which is distinct from the first three-dimensional pattern; wherein a portion of the first pattern extends transversely to and is superimposed over a portion of the second pattern. Thus, even if the Examiner deems that the references may be properly combined, the combination does not teach or suggest the above limitation.

Applicant reiterates that Nelson, Raggio and Azzar et al. each fail to teach or suggest that the outer surface of the molded strip defines a non-extrudable shape. These references further fail to teach or suggest that the shape defined by the outer surface includes a first three-dimensional pattern and a second three-dimensional pattern which is distinct from the first three-dimensional pattern; wherein a portion of the first pattern extends transversely to and is superimposed over a portion of the second pattern.

The Examiner has cited Azzar et al. as teaching a first three-dimensional pattern superimposed over a second three-dimensional pattern. However, the patterns created by Azzar et al. are extrudable and are necessarily so, since the molded strip of Azzar et al. is extruded. In addition, as noted above, Azzar et al. teach that while layer 34 (the first three-dimensional pattern) is superimposed over ribs 12 (the second three-dimensional pattern), no portion of layer 34 extends transversely to ribs 12. Rather, the entirety of layer 34 extends in the same direction as the entirety of rib 12. The extruded nature of the Azzar et al. baseboard strip simply cannot teach a portion of the first pattern being transverse to a portion of the second pattern. Applicant thus submits that claim 18 is allowable in light of the combination of references including Azzar et al.

Claim 18 as amended also requires that the molded strip is formed as an integral one-piece member. In order to teach this limitation, Shaw would have to teach a one-piece integral molded strip having an outer surface defining a first three-dimensional pattern and a second three-dimensional pattern. Shaw teaches away from this because, the second three-dimensional pattern comes from cap 200, which is necessarily a separate piece from corner piece 100, which includes the first three-dimensional pattern on central portion 106. Cap 200 is a separate piece



because its only purpose lies in the fact that it may be installed on corner piece 100 over portion 106 to provide an alternate pattern from that of portion 106 for the purpose of easily changing the ornamental pattern. Thus, Shaw necessarily teaches that the first pattern is on a separate member 200 so that Shaw cannot teach an integral one-piece molding strip as claimed. Applicant thus submits that claim 18 is allowable in light of the combination of references including Shaw and that claims 20-34 and 36-39 are allowable as depending from claim 18.

In light of the discussion above and as detailed below, Applicant further submits that the references fail to teach or suggest the limitations of claims 36-38, 40, 41, 45, 46, 48-50, and that these claims are independently allowable in addition to depending from an allowable claim. Claims 19, 43 and 47 have been canceled.

Claim 36 depends from claim 18 and requires that on the exposed outer surface there is a repeated pattern along the longitudinal length of the molded strip. None of the cited references teach or suggest this limitation.

Claim 37 depends from claim 21 and requires that the at least one ridge is transverse to the elongated direction of the strip.

Claim 38 depends from claim 22 and requires that the at least one recess is transverse to the elongated direction of the strip.

Claim 40 has been amended to require the same limitations indicated above by underlining with regard to claim 18. Applicant thus submits that claim 40 is allowable for the same reasons as claim 18 and that claims 41 and 44 are allowable as depending from claim 40.

Claim 41 depends from claim 40 and requires that the outer surface define a pattern which repeats at least once in the elongated direction of the strip.

Claim 45 has been amended to require the same limitations indicated above by underlining with regard to claim 18. Applicant thus submits that claim 45 is allowable for the same reasons as claim 18, and that claims 46, 48-50 and 52 are allowable as depending from claim 45. In addition, claim 45 requires in part that the method include the step of batch cast molding an elongated strip. Applicant submits that this limitation is neither taught nor suggested by the references. While

the Examiner states that this would be obvious, Applicant submits that none of the cited references state or imply this option. Applicant suggests that the lack of such reference is due to the fact that Applicant's invention as a whole is not obvious and thus, the highly desirable use of batch cast molding to achieve the decorative effects would not have been obvious in light of the cited references. In particular, Nelson focuses only on the use of a thin laminate to form the outer surface of the molded strip. Such laminates are not economically formed by batch cast molding, contrary to the Examiner's comments to that effect. Azzar et al. teach only extrusion and thus any combination with Azzar et al. would not include batch cast molding. Shaw teaches a thin-walled convoluted structure not suited to batch cast molding. Batch cast molding is suited to forming the type of molded strip of Applicant's invention, wherein the molded structure is a substantially solid structure (as opposed to a thin-walled member) wherein the molded structure may simply be removed by a simply single-direction extraction from the mold. The convoluted structure of Shaw would interfere with such removal from a batch casting mold even if the thin walls could be otherwise feasibly produced by batch cast molding. Thus, Shaw teaches away from combination with regard to this limitation.

Claim 46 depends from claim 45 and requires that the exposed outer surface define at least one of a ridge and a recess transverse to the elongated direction of the strip.

Claim 48 depends from claim 45 and recites that the exposed outer surface defines a repeated pattern along the longitudinal length of the molded strip.

Claim 49 depends from claim 45 and recites that the outer surface includes at least one ridge transverse to the elongated direction of the strip.

Claim 50 depends from 45 claim and recites that the outer surface includes at least one recess transverse to the elongated direction of the strip.

## **F. New claims allowable in light of discussion of rejections**

Applicant has added new claims 53-63, including independent claim 56 and claims 57-63 depending therefrom. Applicant submits that in light of the above discussion that said claims are allowable. Applicant re-emphasizes that as discussed above, various of the references cannot be properly combined and that even if they are combined, do not teach or suggest the limitations of claims 53-63. Further, as also detailed above, in order to conclude that Applicant's invention is obvious in light of the cited references, one must undertake impermissible hindsight reconstruction. As argued in various ways above, Shaw simply cannot be properly combined with any of the other references. More detailed rationale is offered below for the allowability of claims 53-63.

Claim 53 depends from claim 18 and recites that another portion of the first pattern is not superimposed over the second pattern. This in particular further defines over Azzar et al., which teach a first pattern (outer layer 34) atop a second pattern (ribs 12). However, layer 34 does not include a portion which is not superimposed over ribs 12, as the entirety of layer 34 is superimposed on ribs 12. If layer 34 were widened to extend outwardly of ribs 12, the second pattern of ribs 12 would then be covered up, which would render useless the decorative characteristic of the second pattern. Thus, Azzar et al. teach away from this limitation.

Claim 54 is the same as claim 52 except it depends from claim 40 and Applicant submits that it is allowable for the same reason.

Claim 55 is the same as claim 52 except it depends from claim 45 and Applicant submits that it is allowable for the same reason.

Claim 56 indicates in part that the elongated molded strip has an exposed outer surface defining a non-extrudable shape. As discussed above, neither Nelson, Raggio nor Azzar et al. teach or suggest a non-extrudable shape. Azzar et al. specifically teach an extruded baseboard molding strip and thus cannot teach this limitation.

Claim 57 requires that the exposed outer surface define at least one of a ridge and a recess transverse to the elongated direction of the strip. The references fail to teach or suggest this limitation.

Claim 58 requires that the exposed outer surface has an upper edge and a lower edge; and that the at least one of a ridge and a recess extends transversely from the upper edge to the lower edge. As previously noted, the metal strap 12 of Raggio in particular teaches away from this limitation. In addition, even if Shaw may be properly combined with the other cited references, only the central portion 106 and beaded cap 200 which removably overlay portion 106 include any decorative pattern. Thus, Shaw fails to teach or suggest this limitation.

Claim 59 requires the step of batch cast molding the elongated strip. As discussed with above with regard to claim 45, the cited references fail to teach or suggests this limitation. The argument regarding claim 45 is incorporated here as well.

Claim 60 indicates that the non-extrudable shape includes at least first and second three-dimensional patterns which are distinct from one another; and wherein a portion of the first pattern extends transversely to and is superimposed over a portion of the second pattern. As noted above, the cited references fail to teach or suggest this limitation.

Claim 61 requires that the elongated strip be formed as an integral one-piece member. This in particular defines over Shaw.

Claim 62 requires that the elongated strip be formed of a single-composition material. This in particular defines over Azzar et al., a key aspect of which is the use of two different-composition materials to respectively create on the one hand the rear layer 36 and ribs 12 and on the other hand the outer layer 34.

Claim 63 requires that the entire outer surface of the molded strip be exposed. This in particular defines over Raggio and Shaw. A substantial portion of the molded strip of Raggio is covered up by metal strap 12. Similarly, cap member 200 of Shaw covers up central portion 106 of corner piece 100. Thus, any combination using either of these two references cannot teach this limitation.

Applicant submits that in light of the extensive arguments presented above that all rejections should be withdrawn and that all pending claims in the application are allowable.

In view of the forgoing, the Applicant respectfully requests reconsideration of the claims and most earnestly solicits the issuance of a Formal Notice of Allowability for the claims.

Please phone the undersigned Attorney if you have any questions remaining after this Amendment.

Respectfully submitted 21<sup>st</sup> day of September, 2004.

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